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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,169	11/13/2003	Bruce D. Williams	13-97	9814

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

MAIL DATE	DELIVERY MODE
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09/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/713,169

Applicant(s)

WILLIAMS ET AL.

Examiner

Lawrence D. Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-16 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-16 and 18-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/22/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the provisional election mailed August 22, 2007. Claims 11 and 20 were amended, claim 17 was cancelled and claim 25 was added rendering claims 11-16 and 18-25 pending. The indicated allowability of claim 17 is withdrawn in view of the newly discovered reference(s) to Kawashima (U.S. 5,415,434). Rejections based on the newly cited reference(s) follow.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections – 35 USC 112, first paragraph***

3. Claims 11-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither the instant claims or specification teaches how much starch content is in non-currency grade paper, which makes it difficult to determine a lower starch amount in the first material, when comparing it to that of non-currency grade paper, as claimed.

***Claim Rejections – 35 USC 112, second paragraph***

4. Claims 11-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In instant claim 11, it is unclear how much starch content is in the non-currency grade paper.

In instant claim 11, it is unclear what the first material is.

***Claim Rejections – 35 USC § 102(b)***

5. Claims 11-14, 16, 18-23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Ahlm, Jr. et al (U.S. 3,001,887).

Ahlm, Jr. discloses verifying the authenticity of a coupon having a surface printed with an indistinguishable material (first material) which will form initially colorless and inherently authenticating words, symbols or designs adapted to be developed in color upon the application of certain chemical agents (column 1, lines 9-45 and 55-65), which meets the limitations of claims 11-13, 16 and 20-23. Because Ahlm, Jr. is silent of starch, it is a good ascertainment that the coupon and first material are free of starch, rendering it to have a lower starch content than non-currency grade paper. Additionally, because Ahlm Jr. is silent of trace chemical residual on the coupon, the applied indistinguishable material (first material coating) has no trace chemical residual on the coupon, as in claims 14 and 18. Because Ahlm, Jr. discloses an indistinguishable material (first material), which is free from starch, which will form initially colorless and inherently authenticating words, symbols or designs adapted to be developed in color

Art Unit: 1774

upon the application of certain chemical agents (column 1, lines 9-45 and 55-65), it is inherent that the coupon is authentic when a light mark results from applying chemical to the coupon and not authentic when a dark mark results from applying a chemical to the coupon.

***Claim Rejections – 35 USC § 103(a)***

6. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahlm, Jr. et al (U.S. 3,001,887) in view Kurrle (U.S. 6,214,766).

Ahlm, Jr. is relied upon for instant claims 11, 20 and 21. Ahlm, Jr. does not explicitly disclose the printing process for applying the coated material to be a flexo device. Kurrle teaches a paper product made to be authenticatable by the application of a printed image containing starch applied to the paper product and where a solution added to the surface of the paper produces an instantaneous blue or black color (column 3, lines 20-31) where the coated printed material can be applied using a flexography printing process. Ahlm, Jr. and Kurrle are both directed to verifying the authenticity of a paper product. It would have been obvious to one of ordinary skill in the art to have applied to coated printed material using flexography, as taught in Kurrle, in the paper or coupon of Ahlm, Jr. to produce an improved layer of material on the surface of the paper, which will not readily come off the surface.

***Claim Rejections – 35 USC § 102(b)***

Art Unit: 1774

7. Claims 11-16, 18-23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawashima (U.S. 5,415,434).

Kawashima discloses a printed matter (coupon) with a color developing area having a coloring compound (first material) that is changed from a colorless to colored state by application of a color coupling additive (column 1, lines 5-68 and Figure 1) which meets claims 11-13, 16 and 20-23. Kawashima further discloses the color applicator can be marked with a pen (column 7, lines 6-11) as in instant claim 15. Because Kawashima is silent of starch, it is a good ascertainment that the coupon and first material are free of starch, rendering it to have a lower starch content than non-currency grade paper. Additionally, because Kawashima is silent of trace chemical residual on the coupon, the applied indistinguishable material (first material coating) has no trace chemical residual on the coupon, as in claims 14 and 18. Because Kawashima discloses a coloring compound (first material), which is free from starch, which is changed from a colorless to colored state by application of a color coupling additive (column 1, lines 5-68 and Figure 1), it is inherent that the coupon is authentic when a light mark results from applying chemical to the coupon and not authentic when a dark mark results from applying a chemical to the coupon.

***Claim Rejections – 35 USC § 103(a)***

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawashima (U.S. 5,415,434) in view Kurrle (U.S. 6,214,766).

Kawashima (U.S. 5,415,434) is relied upon for instant claims 11, 20 and 21. Kawashima (U.S. 5,415,434) does not explicitly disclose the printing process for applying the coated material to be a flexo device. Kurrle teaches a paper product made to be authenticatable by the application of a printed image containing starch applied to the paper product and where a solution added to the surface of the paper produces an instantaneous blue or black color (column 3, lines 20-31) where the coated printed material can be applied using a flexography printing process. Kawashima (U.S. 5,415,434) and Kurrle are both directed to verifying the authenticity of a paper product. It would have been obvious to one of ordinary skill in the art to have applied to coated printed material using flexography, as taught in Kurrle, in the paper or coupon of Kawashima (U.S. 5,415,434) to produce an improved layer of material on the surface of the paper, which will not readily come off the surface.

### ***Response to Arguments***

9. Applicant's arguments of the claims rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement have been considered but are unpersuasive. Applicant states the amount of starch content of non-currency grade paper is relative to the starch content of the first material, thus the exact amount of starch content is not needed. Applicant's arguments are well taken; however, it remains unclear as to how much starch content is found in non-currency grade paper. Examiner maintains this information is essential in determining how much starch

Art Unit: 1774

content is found in the first material, based upon instant claim 11. Applicant has not convincingly taught what is a known amount of starch content in non-currency grade paper within the art. No clear support of a starch content value can be determined from Applicant's arguments. Applicant states an absolute amount of starch is not claimed, only a relative amount. Neither an absolute nor a relative amount of starch content has been claimed by Applicant within the instantly claimed invention. Therefore, Examiner maintains that because there is no teaching of the starch content in non-currency grade paper, it is difficult to determine a lower starch amount in the first material, when comparing it to that of non-currency grade paper, as claimed. As a result, the rejection made under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is maintained for reasons of record.

Applicant's arguments of the claims rejected under 35 U.S.C. 112, second paragraph, have been considered but are unpersuasive. Applicant argues claim 11 recites a comparative starch content, not an absolute content; therefore, claims 11-24 point out the claimed subject matter. Although Applicant does compare starch content of a first material with that of non-currency grade paper, it remains unclear as to how much starch content is found in non-currency grade paper. This information is essential in determining how much starch content is found in the first material, based upon instant claim 11. No amount of starch content has been claimed by Applicant within the instantly claimed invention. Therefore, Examiner maintains that because there is no teaching of the starch content in non-currency grade paper, it is difficult to determine a lower starch amount in the first material, when comparing it to that of non-currency

grade paper, as claimed. As a result, the rejection made under 35 U.S.C. 112, second paragraph, is maintained for reasons of record.

Applicants arguments to the rejection made under 35 U.S.C. 102(b) as being anticipated by Collings (U.S. 5,188,871) have been considered and the rejection is withdrawn due to Applicants arguments and the starch content of the composition.

Applicants arguments to the rejection made under 35 U.S.C. 103(a) as being unpatentable over Collings (U.S. 5,188,871) in view Kurrle (U.S. 6,214,766) have been considered and the rejection is withdrawn due to Applicants arguments and the starch content of the composition.

Applicants arguments to the rejection made under 35 U.S.C. 102(b) as being anticipated by Ahlm, Jr. et al (U.S. 3,001,887) has been considered but is unpersuasive. After further consideration of the Ahlm, Jr. reference, because Ahlm, Jr. discloses an indistinguishable material (first material), which is free from starch, which will form initially colorless and inherently authenticating words, symbols or designs adapted to be developed in color upon the application of certain chemical agents (column 1, lines 9-45 and 55-65), it is inherent that the coupon is authentic when a light mark results from applying chemical to the coupon and not authentic when a dark mark results from applying a chemical to the coupon.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-

Art Unit: 1774

272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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